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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Geetha Ravishankar

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08/30/2005

LEON R TURKEVICH

2000 M STREET NW

7TH FLOOR

WASHINGTON, DC 200363307

EXAMINER

LESNIEWSKI, VICTOR D

ART UNIT

PAPER NUMBER

2152

DATE MAILED: 08/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/820,884

Applicant(s)

RAVISHANKAR ET AL.

Examiner

Victor Lesniewski

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The amendment filed 6/13/2005 has been placed of record in the file.
2. Claims 12 and 24 have been amended.
3. The objection to claim 24 is withdrawn in view of the amendment.
4. Claims 1-40 are now pending.
5. The applicant's arguments with respect to claims 1-40 have been fully considered but they are not persuasive. A detailed discussion is set forth below.

Response to Amendment

6. Claim 12 has been amended to make a minor adjustment to the wording of the claim. Claim 24 has been amended to properly identify the claim as dependent on claim 23. The amendments do not prove a change in scope to the limitations of claims 12 and 24.

Claim Rejections - 35 USC § 103

7. Claims 1, 11, 12, 18, 19, 29, 30, and 40 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Bates et al. (U.S. Patent Number 6,631,181), hereinafter referred to as Bates, in view of Fuller et al. (U.S. Patent Number 6,545,589), hereinafter referred to as Fuller, as presented in the previous action mailed 3/15/2005. Claims 2-6, 8, 13-16, 20-24, 26, 31-35, and 37 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Bates in view of Fuller, further in view of Edmonds et al. (U.S. Patent Number 6,230,190) as presented in the previous action mailed 3/15/2005. Claims 7, 25, and 36 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Bates in view of Fuller, further in view of Edmonds et al., further in view of

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Official Notice as presented in the previous action mailed 3/15/2005. Claims 9, 10, 17, 27, 28, 38, and 39 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Bates in view of Fuller, further in view of Gebhardt et al. (U.S. Patent Number 6,769,027) as presented in the previous action mailed 3/15/2005.

Response to Arguments

8. In the remarks, the applicant has argued:

- <Argument 1>

The combination of Bates and Fuller does not disclose the features of claim 1 because it does not disclose “retrieving an alternate announcement from an alternate source (e.g., the directory server) based on the determined unavailability of a stored subscriber announcement from a first source (e.g., the messaging server)” as stated in the remarks on page 13.

- <Argument 2>

Bates teaches away from the limitations of claim 1.

9. In response to argument 1, the combination of Bates and Fuller does disclose the limitations of claim 1. It is noted that “retrieving an alternate announcement from an alternate source” is not a limitation of the claim. First, the claim states retrieving “an audible subscriber identifier” not “an alternate announcement.” Second, the claim states retrieving the identifier from a “directory server” and not “an alternate source.” Although it is understood that the directory server is separate from a messaging server, the terminology “an alternate source” is not present in the claim. The applicant is reminded that although the claims are interpreted in light

of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

10. In support of argument 1, the applicant has stated that Bates teaches storing all greetings in the same disk memory and that Fuller teaches storing all subscriber records on the same disk, thus an alternate location is not disclosed. Again, “an alternate location” is not a limitation of the claim. Claim 1 states the use of a messaging server which limitation is met by the previous citation to Bates, figure 1, item 10. Claim 1 also states the use of a directory server which limitation is met by the previous citation to Fuller, column 25, line 63 through column 26, line 2. For further clarification of Fuller’s disk as representation of a directory server, the applicant is directed to Fuller, column 19, line 62 through column 20, line 6.

11. Further, the applicant has argued against both Bates and Fuller individually as not disclosing both the messaging server and the directory server of claim 1. However, the rejection of claim 1 is based on the combination of Bates and Fuller. The applicant is reminded that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

12. In response to argument 2, it is maintained that Bates does not teach away from the limitations of claim 1. Claim 1 recites “determining an unavailability of the subscriber announcement.” It is maintained that the previous citation to Bates, column 7, lines 13-16 teaches this limitation and does not teach away from it. Bates clearly states that “if a pre-recorded greeting is not designated for the caller ID,” a default greeting is played. A pre-recorded greeting not being designated for the call meets the limitation of a subscriber

announcement being unavailable. There is no pre-recorded greeting available for the call in the system of Bates, and thus a default is played.

13. Furthermore, the applicant has stated that the combination of Bates and Fuller does not address the problems addressed by the inventors. Here the applicant is reminded that the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. It is maintained that claim 1 is not patentably distinguished over the combination of Bates and Fuller as the combination discloses all of the limitations of the claim.

14. In addition, the applicant has argued that claims rejected under 35 U.S.C. 103, but not explicitly discussed, are allowable based on the above arguments. Thus, claims disclosing similar limitations to the discussed claims and related dependent claims remain rejected under the same reasoning as presented above.

Conclusion

15. **THIS ACTION IS MADE FINAL.** The applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor Lesniewski whose telephone number is 571-272-3987.

The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Victor Lesniewski
Patent Examiner
Group Art Unit 2152



Dung C. Dinh
Primary Examiner